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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,303	10/10/2003	Terry J. Sills	301-002	3325
33354	7590	11/22/2005		
ETHERTON LAW GROUP, LLC 5555 E. VAN BUREN STREET, SUITE 100 PHOENIX, AZ 85008			EXAMINER GREEN, BRIAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,303

Applicant(s)

SILLS, TERRY J.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species I. (Figures 1-3) in the reply filed on Aug. 15, 2005 is acknowledged.

Claims 10-15 and 21-23 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Aug. 15, 2005.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one non-approving facial indicium and at least one smiling indicium as defined in claims 5 and 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

Art Unit: 3611

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to indicate that the at least one reference marker can include a smiling face and a non-approving facial indicium as defined in claim 5.

Claim Objections

Claim 8 is objected to because of the following informalities: In claim 8, line 1, "the display" should be "the at least one display" to be consistent with claim 1, line 4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-9 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, claims 2-7, line 1, and claim 8, lines 1-2, "at least one reference marker" is confusing since it is not clear whether the applicant is referring to the "at least one reference

Art Unit: 3611

marker” defined earlier. In claim 1, line 5, “at least one display” is confusing since it is not clear whether the applicant is referring to the “at least one display” defined in claim 1, line 4. Claim 5 is indefinite since it is not clear how the at least one reference marker can comprise both a smiling face and a non-approving facial indicium. Claim 6 is indefinite since it is not clear whether the smiley face is the same as the smiling indicium defined in claim 4. In claims 9 and 20, line 2, it is improper to use trademarks (Post-It note) in a claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,8,9,16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (U.S. Patent No. 5,464,672).

Jackson shows in figures 1-2 an object orientation system comprising at least one display (the notepad) and at least one reference marker (18). In regard to claims 8,9,19, and 20, Jackson discloses that the notepad includes Post-It note sheets, see column 1, lines 5-15.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,8,9,16, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sabella (U.S. Patent No. 6,703,096).

Sabella shows in figures 1-3 an object orientation system comprising at least one display (the notepad) and at least one reference marker (23,23a). In regard to claims 8,9,19, and 20, Sabella discloses that the notepad includes adhesive sheets (16) which are the same as Post-It note sheets.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7,17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent No. 5,464,672).

Jackson discloses the applicant's basic inventive concept except for the particular used in forming the reference marker, i.e. smiling or frowning face. It would have been obvious to one skilled in the art to modify Jackson by making the marker in the form of a smiling or frowning face since it is considered an obvious matter of design to vary the indicia displayed as desired. The particular indicia displayed is not considered to be a patentable feature.

Claims 2-7,17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabella (U.S. Patent No. 6,703,096).

Art Unit: 3611

Sabella discloses the applicant's basic inventive concept except for the particular used in forming the reference marker, i.e. smiling or frowning face. It would have been obvious to one skilled in the art to modify Jackson by making the marker in the form of a smiling or frowning face since it is considered an obvious matter of design to vary the indicia displayed as desired. The particular indicia displayed is not considered to be a patentable feature.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McNab et al., Raymer, and Chen teach the use of indicia on the edges of a notepad.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg
Nov. 14, 2005


BRIAN K. GREEN
PRIMARY EXAMINER